REMARKS/ARGUMENTS

This is in response to the official action dated September 19, 2008. Reconsideration is respectfully requested.

In that office action, the Examiner acknowledges the withdrawal of rejections of claims 4-11 under 35 USC 112, second paragraph, the rejection of claims 4-14 under 35 USC 102 and the rejection of claims 1-2 under 35 USC 103 (a) in view of applicant's amendments filed 8/12/08.

Rejections under 35 USC 101

Claims 1-2 and 4-14 remain rejected for being directed to non-statutory subject matter. According to the Examiner, the claims are drawn to a process or a computer readable medium comprising computer executable instructions to perform the process or a system for performing the process, for determining an optimal test order for diagnosing mutations related to a disease. The Examiner considers the claims being directed at a process comprising receiving data, creating a database, receiving new data, applying a decision tree algorithm and generating a recommendation. Further, the Examiner states that the invention does not transform an article or physical object to a different state or thing outside a computation device. The Examiner further contends that the claimed process does not produce a useful, concrete and tangible result.

Applicant has amended claims 1, 4, 5, and 12 to clarify that the determined optimal genetic test order (claims 1, 4 and 12) and the projected cost (claim 5) is presented to a user via an output device.

Applicant respectfully submits that the amendments to the process claims overcome the Examiner's rejections as they now recite a step of outputting the specific final result to the user. Applicant further submits that these amendments do not introduce new matter.

Claims 1-2 are directed to a computer readable medium having computer-executable instructions that when executed by a computer cause the computer to perform a method for determining an optimal genetic test order. The Examiner has rejected these claims on the basis that "computer

readable medium" indicates carrier waves (signals). Applicant has not claimed that any "carrier waves (signals)" are part of this invention.

Applicant also submits that under the recently discussed test for determining statutory subject matter as espoused by the Federal Circuit in the recent decision *In re Bilski,* Fed. Cir. 2007-1130, the "machine-or-transformation test" is met with the submitted amendment. "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article." *In re Bilski*, at 24 (emphasis added).

In the September 19, 2008 Advisory Action the Examiner maintains that the claimed process is not statutory. Applicants respectfully submits that claims now produce a useful contrete and tangible result, they identify an optimal genetic test order and the final result is used and made available to be used by a user.

Applicant submits that the also the second branch of the test is met by the process claims of the present application. The *Bilski* decision identified some illustrative examples establishing processes in which a transformation or reduction of an article into a different state or thing constituted patent-eligible subject matter. A claim involving the transformation of data to constitute patent-eligible subject matter should "specify any particular type of data or nature of data; or specify how or from where the data was obtained or what the data represented." *In re Bilski*, at 25. The process claims of the present application specify a particular type of data or nature of data. Specifically, the process claims expressly specify the particular type of data or nature of the data being transformed. The *In re Bilski* court referred to the previous Federal Circuit decision *In re Abele*, which recognized that X-ray attenuation data clearly represented physical and tangible objects. (Id. at 26.) Furthermore, the Court in reviewing the Abele decision also concluded that "the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible." (Id. at 26.) "We further note for clarity that the electronic transformation of the data itself into a visual depiction in *Abele* was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented." (Id. at 26.)(emphasis added) Applying these principles to the present claimed invention the claims need not transform the underlying physical object that the data represents, instead the mere electronic

transformation of the data itself by disregarding certain input data records based on specified criteria or conditions itself is enough to satisfy this prong of the two part inquiry.

Having established that the machine-or-transformation test have been met, Applicants submit that the present claimed method constitutes patent-eligible statutory subject matter and requests that the rejection under 35 U.S.C. §101 be withdrawn.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,
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